

Applicant: William Galbraith
Application Serial No.: 10/804,592
Filing Date: March 19, 2004
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REMARKS/ARGUMENTS

Reconsideration of this application is respectfully requested.

This Amendment is being filed in response to an Office Action which was issued on April 7, 2005. It is respectfully submitted that the present Amendment is timely submitted in view of the concurrently-filed Petition for One Month Extension of Time.

Claims 1-6 and 24-31 are pending and under examination in the application. By this Amendment, claims 1, 24, 28, and 29 have been amended.

At the onset, Applicant notes that a Supplemental Declaration is being filed concurrently herewith. As noted in the attached Submission, the Supplemental Declaration corrects certain typographical errors uncovered in the original Declaration.

Claim Rejections Under 35 U.S.C. §112

The Examiner rejected claims 1-6 and 24-31 under 35 U.S.C. §112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Specifically, the Examiner rejected claims 1 and 24 under §112, second paragraph, alleging that "it is unclear whether the salt or ester thereof refers to a salt or ester of bromosulfophthalein or any salt or ester that can be a ligand." In response, applicant has amended claims 1 and 24 to indicate that both the salt and ester recited therein refer, respectively, to salts of bromosulfophthalein, and esters of bromosulfophthalein.

The Examiner rejected claims 28 and 29, alleging that "it is unclear whether one or more additional supports are intended for one or more non-albumin proteins because it is vague as to whether more than one non-albumin protein can be bound to only one additional support." Applicant has amended claims 28 and 29 to indicate that each additional support is bindable to one or more non-albumin proteins.

The Examiner rejected claim 31, alleging that "the Protein G cartridge, Protein A cartridge, and Protein A and G cartridge are vague because it is unclear what is encompassed by 'cartridge'." The Examiner further alleged that it "is unclear whether a cartridge is the insoluble support of claim 29." Applicant respectfully directs the Examiner's attention to paragraphs [0058], [0066], and [0067] of the subject specification, in which reference is made to "cartridges." As noted in paragraph 58, the one or more additional insoluble supports "may include a support adapted to bind IgG, such as a Protein A cartridge, Protein G cartridge, and/or a combination Protein A and Protein G cartridge." The cartridges mentioned therein are well

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known to those skilled in the art. A simple Internet search uncovers multiple hits for Protein A, Protein G, and Protein A and Protein G cartridges.

The Examiner rejected claims 28-31, alleging that the phrase “adapted to be capable of binding” is “vague because it is unclear what structural limitations are necessary for the support to be adapted for binding.” The Examiner further alleged that it is “unclear what type of adaptation for binding is required, for instance if ligands are attached to the support or whether the support requires a type of coating which enhances binding.” In response, applicant has amended claims 28-31, replacing the language “adapted to be capable of binding” with “bindable to.” In view of the foregoing, it is respectfully submitted that the claims are in accord with 35 U.S.C. §112.

Claim Rejections Under 35 U.S.C. §102

The Examiner rejected claims 1-6 and 24-27 under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 5,919,708 (hereinafter, “Sundrehagen”). This rejection is respectfully traversed.

Applicant notes that amended claims 1 and 24 require a ligand “comprising bromosulfophthalein or a salt of bromosulfophthalein or ester of bromosulfophthalein.” Sundrehagen does not disclose or suggest the use of a bromosulfophthalein ligand, or a salt

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thereof or ester thereof. Applicant respectfully points out that the ligand of Sundrehagen to which the Examiner referred (col. 11, lines 49-54) is not a bromosulfophthalein, but rather bromosulphophthalein-glutathione. There is no disclosure or suggestion of the use of bromosulfophthalein. It is respectfully submitted that claims 1 and 24, along with dependent claims 2-6 and 25-27, are patentable over Sundrehagen.

Claim Rejections Under 35 U.S.C. §103

The Examiner rejected claims 24 and 27-31 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pub. No. 2002/0127739 (hereinafter, "Pieper") in view of Sundrehagen. The Examiner admitted that "Pieper et al. fail to teach a ligand of bromosulfophthalein" and relied on Sundrehagen for allegedly overcoming this deficiency.

In response, Sundrehagen does not disclose or suggest the use of bromosulfophthalein as recited in claim 24, contrary to the Examiner's assertion. Rather as noted above, Sundrehagen discloses the use of bromosulphophthalein-glutathione. The hypothetical combination of Pieper and Sundrehagen would use Pieper's method with bromosulphophthalein-glutathione, not bromosulfophthalein. Accordingly, the hypothetical combination of Pieper and Sundrehagen does not teach each and every element of claims 24 and 27-31. It is respectfully submitted that claims 24 and 27-31 are patentable over Pieper in view of Sundrehagen.

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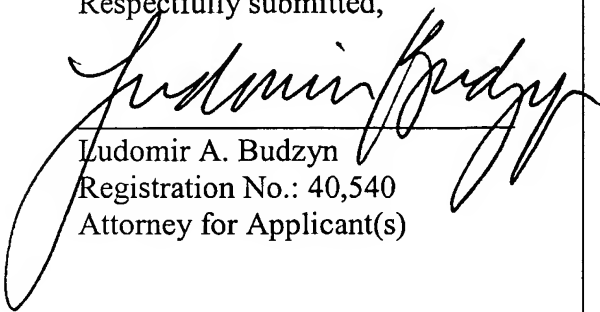
Double Patenting

The Examiner asserted that claims 2 and 4 and claims 3 and 5 are "substantial" duplicates. The claims are not duplicates and as set forth in MPEP §706.03(k), applicant has a "right to restate (i.e., by plural claiming) the invention in a reasonable number of ways. Indeed, a mere difference in scope between claims has been held to be enough."

The Examiner also provisionally rejected claims 1-6 and 24-31 as claiming the same invention as that of claims 1-6 and 24-31 of co-pending Application No. 10/922,560. For the record, claims 1-6 and 24-31 are being cancelled from co-pending Application No. 10/922,560.

Favorable action is earnestly solicited. If there are any questions or if additional information is required, the Examiner is respectfully requested to contact applicant's attorney at the number listed below.

Respectfully submitted,


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